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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,247	06/27/2001	Koichi Hatakeyama	Q65047	2062

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SUGHRUE, MION, ZINN,
MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,247

Applicant(s)

HATAKEYAMA, KOICHI

Examiner

Rob Rhode

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amendment of 10-15-04 amended claims 2 and 9 and added new claims 15 - 21 as well as traversed rejections of Claims 1 - 14.

Currently, claims 1- 21 are pending.

Information Disclosure Statement

The information disclosure statement filed 7/12/2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent and NPL listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 14 are rejected under 35 U.S.C. 102(e) as being unpatentable over Ogasawara (US 6,577,861 B2).

Regarding claim 1 and related claims 6, 8 and 13 Ogasawara teaches a simple payment method and system for merchandise purchased by a mobile telephone terminal, comprising the steps of:

transmitting a request, which merchandise information desired by a mobile telephone terminal and storing in a server is transmitted from said server to a mobile telephone terminal for an on-line shopping, from said mobile telephone terminal to said server (see at least Abstract and Figures 5 – 8); receiving said desired merchandise information transmitted from said server at said mobile telephone terminal (see at least Col 2, lines 39 – 64 and Figure 2); making a purchase order for merchandise desired by said mobile telephone terminal at said mobile telephone terminal (see at least Figure 5); inserting a prepaid card or a debit card into a slot of a card reader provided in said mobile telephone terminal (see at least Col 4, lines 46 – 50 and Figure 3); inputting a password of a user who ordered said desired merchandise to said mobile telephone terminal (see at least Col 5, lines 2 – 29); transmitting said purchase order, information of said prepaid card or said debit card, and said password to said server from said mobile telephone terminal (see at least Figures 2, 6 and 7); confirming said purchase order and said information of said prepaid card or said debit card at said server, and at the same time comparing said password with a password registered beforehand in said server at said server (see at least Figures 2, 6 and 7); authenticating said purchase order and said information of said prepaid card or said debit card and said password at

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said server (see at least Col 16, lines 11 – 30); instructing to deliver said merchandise to an address registered beforehand corresponding to said password when said server authenticated said information transmitted from said mobile telephone terminal (see at least Col 1, lines 43 - 46); and subtracting the amount of said delivered merchandise from said prepaid card or the bank account of said debit card at said server (see at least Col 18, lines 20 – 54).

Regarding claim 2 and related claim 9, Ogaswara teaches a simple payment method, wherein said server transmits merchandise information at said online shopping to said telephone terminal to the access from said mobile telephone terminal (Col 3, lines 1 – 3 and 52 as well as Col 5, lines 39 – 44).

Regarding claim 3 and related claim 10, Ogasawara teaches a simple payment system for merchandise purchased by a mobile telephone terminal, wherein said server compares said information read by said card reader and a password inputted from said mobile telephone terminal with information registered in said server beforehand and confirms the authenticity of said information read by said card reader and said password (Col 6, line 1 - 3).

Regarding claim 4 and related claim 11, Ogasawara teaches a simple payment system for merchandise purchased by a mobile telephone terminal, wherein said server instruct to deliver said merchandise ordered by said mobile telephone terminal on said on-line shopping to an address registered beforehand corresponding to said mobile telephone

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terminal when said server authenticated said information transmitted from said mobile telephone terminal (see at least Abstract, Col 1, lines 43 – 46 and Figures 2, 6, 7 and 9).

Regarding claim 5 and related claims 7, 12 and 14, Ogasawara teaches a simple payment system for merchandise purchased by a mobile telephone terminal, wherein said card reader is assembled in said mobile telephone terminal or is connected to said mobile telephone terminal (Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Amazon.com and Sprint First to Offer Internet Shopping on Wireless Phones”, Business Editors, High-Tech Writers, Business Wire; New York; Dec. 8, 1999 (hereafter referred to as “Amazon”) in view of Ogasawara (US 6,577,861 B2).

Regarding claim 15 and related claim 19 (new), Amazon teaches a method of ordering and paying for merchandise, comprising: accessing the internet through the use of a mobile phone; displaying on the mobile phone an internet webpage, through which

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merchandise can be purchased; selecting merchandise for purchase on the webpage through use of the mobile phone (see Pages 1 and 2).

While Amazon discloses shopping online via a wireless phone, which implicitly would include payment, the reference does not specifically disclose and teach a method of reading information from a payment card at a card reader connected to the mobile phone; charging the payment card for the purchase of the selected merchandise.

On the other hand and in the same area of online wireless shopping, Ogasawara teaches a method of reading information from a payment card at a card reader connected to the mobile phone; charging the payment card for the purchase of the selected merchandise (see at least Col 12, lines 10 –14 and Figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Amazon with the method of Ogaswara to have enabled a method of reading information from a payment card at a card reader connected to the mobile phone; charging the payment card for the purchase of the selected merchandise. Amazon discloses a method for purchasing online via a wireless phone (Pages 1 and 2). Ogaswara discloses a wireless online shopping method, which includes a slot for a card reader to insert a payment card in order to charge the shopper for the purchased item (Col 12, lines 10 –14 and Figure 2). Thereby, one of ordinary skill in the art would have been motivated to extend the method of Amazon with a method for reading

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information from a payment card at a card reader connected to the mobile phone;
charging the payment card for the purchase of the selected merchandise.

Regarding claim 16 (new), Ogaswara teaches a merchandise ordering and payment, wherein the server compares information read from the payment card and a password input by the user with information previously registered in the server and thereby confirms the authenticity of the information read from the payment card and the password (Col 7, lines 24 – 33).

Regarding claim 17 (new), Ogaswara teaches a merchandise ordering and payment system, wherein, the server instructs the delivery of the ordered merchandise to an address previously registered in the server and associated with the mobile telephone (Col 1, lines 44 – 46).

Regarding claim 18 (new), Ogaswara teaches a method of merchandise ordering and payment system according, wherein the card reader is incorporated within the body of the mobile telephone (Figure 2).

Regarding claim 20 (new), Ogaswara teaches a method, further comprising, prior to the step of debiting the payment card, comparing the information read from the payment card to information previously stored in a server, and thereby authenticating the information read from the payment card (Col 7, lines 24 – 31).

Regarding claim 21 (new), Ogasawara teaches a method, further comprising, prior to the step of debiting the payment card, inputting a password into the mobile phone, transmitting the password to a server, comparing the input password to a password previously stored in a server, and authenticating that the input password is the same as the password previously stored in the server (Col 6, lines 1 – 14).

Response to Arguments

Applicant's arguments filed 10/15/2004 have been fully considered but they are not persuasive.

The applicant argues that Ogaswara does not disclose or teach a prepaid card.

First, the applicant's invention is not just the use of a prepaid card with an online shopping method. Rather, the applicant's invention is a method for wireless online shopping and payment with a card reader incorporated into the wireless device, which includes authentication of the shopper by the server as well as transmitting requested merchandise information from the server to the shopper. Additionally, the reader as disclosed by the reference would have been capable of reading a card including a prepaid card. Moreover, Ogasawara would have fairly suggested and taught one of ordinary skill in the art that the imbedded card reader of Ogasawara includes the capability to "read" a card for payment purposes, which include a prepaid card such as an electronic cash card (Col 7, lines 31 – 33).

The applicant argues that Ogaswara does not disclose or suggest requested merchandise information being transmitted to mobile phone.

In a reasonable broad interpretation of the claims, Ogaswara would fairly suggest and teach one of ordinary skill that requested merchandise information is transmitted to the shopper from the server (Col 3, lines 1 – 3 and 52 as well as Col 5, lines 39 – 44).

The applicant argues that Ogaswara does not disclose and teach delivery and there is no motivation to combine the delivery disclosed in the background with the reference.

First, the background of Ogaswara fully discloses that delivery of merchandise order online as well as payment is old and well known (Col 1, lines 38 – 47). Second, this rejection was based on a 35 USC 102 (e) rejection and therefore no motivation was required. Third, the background information provided in a patent does not preclude the teachings provided in the background. Forth, the reference does fairly suggest and teach that that delivery of merchandise can be included as part of an online order when the shopper is not in the store. (Col 1, lines 40 – 46, Col 5, lines 30 – 34 and Col 9, 43 - 47).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 305-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

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Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

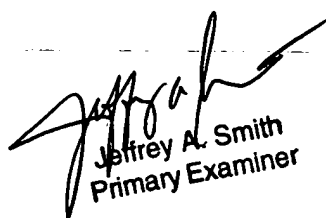
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

RER



Jeffrey A. Smith
Primary Examiner